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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,649	02/29/2000	Kiyoshi Toyoda	PI9157	2077
7055	7590	05/02/2006		EXAMINER
		GREENBLUM & BERNSTEIN, P.L.C.		PARK, CHAN S
		1950 ROLAND CLARKE PLACE		
		RESTON, VA 20191	ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/514,649	TOYODA, KIYOSHI
	Examiner	Art Unit
	CHAN S. PARK	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 April 2006.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 19-27 and 30-35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 19, 23 and 27 is/are allowed.  
 6) Claim(s) 20-22, 24-26 and 30-35 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN  
PRIMARY EXAMINER

*Tran, Douglas Q.*

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

1. Applicant's amendment was received on 4/5/06, and has been entered and made of record. Currently, **claims 19-27 and 30-35** are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to **claims 20-22, 24-26 and 30-35** have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

3. **Claims 19, 23 and 27** remain allowed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 21, 24, 25, 30, 31, 33 and 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hull et al. U.S. Patent No. 6,665,086 (hereinafter Hull) in view of Endo U.S. Patent No. 6,801,340.

4. With respect to claim 20, Hull discloses an image communication apparatus (fax 110 in fig. 1) comprising:

a scanner configured to scan image data (col. 7, lines 1-4);

a panel configured to input a telephone number of a recipient (col. 6, lines 55-56);

a memory configured to store an address of a management center (document management workstation 108 in fig. 1 & col. 7, lines 11-18); and

a controller configured to:

convert the scanned image data into data for network transmission (fig. 7);

and

independently transmit the image data to each of the telephone number of the recipient input by the panel and the address of the management center, the management center managing information that the image communication apparatus transmits to the telephone number of the recipient input by the panel, and being further connected to the image communication apparatus via the network, the management center being distinct from the recipient of the telephone number input by the panel, the address of the management center being independent of the recipient of the telephone number input by the panel, the image data being transmitted to the management center based on the address stored in the memory and further based on a request to transmit the image data to the address of the recipient and without a request by a user to transmit the image data to the management center (fig. 7 & col. 2, lines 1-8 & col. 7, lines 11-27).

Hull, however, does not explicitly disclose an image communication apparatus for converting and transmitting the scanned image data in an email format in facsimile communication.

Endo, the same field of endeavor of the facsimile transmission art, discloses an image communication apparatus (fig. 3) comprising:

a scanner configured to scan image data (scanner 210);

a panel configured to input an address of a recipient (col. 4, lines 29-35);

a memory configured to store an e-mail address of a management center (either database 104 or file server 103 in fig. 1); and

a controller configured to:

convert the scanned image data into data for Internet transmission (converter 308 in fig. 3);

attach the converted data to an e-mail (converter 308 in fig. 3); and

independently transmit the e-mail to each of the address of the recipient input by the panel and the e-mail address of the management center (fig. 4), the management center (either database 104 or file server 103 in fig. 1) managing information (same image data and image data information transmitted to other destinations) that the image communication apparatus transmits to the address of the recipient input by the panel, and being further connected to the image communication apparatus via the Internet, the management center being distinct from the recipient of the address input by the panel (fig. 4), the e-mail address of the management center being independent of the recipient of the address input

by the panel (fig. 4), the e-mail being transmitted to the management center based on the e-mail address stored in the memory (fig. 4).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the Internet facsimile function of Endo into the facsimile archiving system of Hull to independently transmit the image data in the email format.

The suggestion/motivation for doing so would have been to implement the facsimile archiving system in the email facsimile system.

Therefore, it would have been obvious to combine Hull with Endo to obtain the invention as specified in claim 20.

5. With respect to claim 21, Hull discloses the image communication apparatus, wherein the management center stores the information that the image communication apparatus transmits to the recipient, the information being browsed by a supervisor of the management center (col. 7, lines 19-23 & col. 8, lines 30-47).

6. With respect to claims 24, 30 and 33, arguments analogous to those presented for claim 20, are applicable.

7. With respect to claims 25, 31 and 34, arguments analogous to those presented for claim 21, are applicable.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hull and Endo as applied to claim 20 above, and further in view of Wolf U.S. Patent No. 6,535,303.

8. With respect to claim 22, the combination discloses the image communication apparatus according to claim 20, but it does not disclose expressly that the controller sets a mail address of a transmission destination in a "To" field of the email and sets a mail address of the management center in a "Bcc" field of the email.

Wolf, the same field of endeavor of the facsimile transmission and broadcast art, discloses a facsimile controller for setting destination addresses in both "To" and "Bcc" fields of the e-mail for facsimile transmission (col. 6, lines 43-56).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the means for setting the destination addresses in both "To" and "Bcc" fields of the e-mail of Wolf with the facsimile apparatus of Endo.

The suggestion/motivation for doing so would have been to distinguish the addresses of the final destinations and to broadcast the facsimile image data using the "To" and "Bcc" fields of the e-mail.

Therefore, it would have been obvious to combine Endo with Wolf to obtain the invention as specified in claim 22.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hull and Endo as applied to claim 30 above, and further in view of Wolf.

9. With respect to claim 32, arguments analogous to those presented for claim 22, are applicable.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hull and Endo as applied to claim 24 above, and further in view of Wolf.

10. With respect to claim 26, the combination discloses the image communication apparatus according to claim 24, but it does not disclose expressly that the e-mail transmitter sets an email address of the management center in a "To" field of the email.

Wolf, the same field of endeavor of the facsimile transmission and broadcast art, discloses a facsimile controller for setting destination address in "To" field of the e-mail for facsimile transmission (col. 6, lines 43-56).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the means for setting the destination address in "To" field of the e-mail of Wolf with the facsimile apparatus of Endo.

The suggestion/motivation for doing so would have been to distinguish the addresses of the final destinations using "To" field.

Therefore, it would have been obvious to combine Endo with Wolf to obtain the invention as specified in claim 26.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hull and Endo as applied to claim 33 above, and further in view of Wolf.

11. With respect to claim 35, arguments analogous to those presented for claim 33, are applicable.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park  
Examiner  
Art Unit 2625

*Chan S. Park*

csp  
April 26, 2006

*Tranlong*  
DOUGLAS Q. TRAN  
PRIMARY EXAMINER